

REMARKS

Claims 7, 11 and 13-18 are pending in the instant application, of which claims 11 and 14 are withdrawn. By the instant amendment, claims 7 and 17 are amended. Claims 7 and 17 are independent.

Applicant requests, in the next Office action, that the Examiner indicate the acceptability of the drawings filed February 16, 2001.

Claims 7, 13 and 15-18 are presented to the Examiner for further prosecution on the merits.

A. Introduction

In the outstanding Office Action Made Final, the Examiner objected to claims 7, 13 and 15-18, rejected claim 7 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,963,843 to Takatsu ("the Takatsu reference"), rejected claims 13, 15, 16 and 18 under 35 U.S.C. § 103(a) as being unpatentable over the Takatsu reference, and objected to claim 17 as being dependent upon an allowable base claim, while indicating that claim 17 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

B. Asserted Objection to Claims 7, 13 and 15-18

In the outstanding Office Action Made Final, the Examiner objected to claims 7, 13 and 15-18. In particular, the Examiner asserted,

Claims 7, 13 and 15-18 are objected to as containing the phrase "cyber space ..." and "cyber payment ...". It is not clear as what the applicant specific meaning of the word "cyber" is. One skilled in the art would consider the word as being electronic or digital. There is no specific physical definition as to describe a "cyberspace". It is used in the art as to describe the internet and the World Wide Web as "cyber space". Further more what transpire on the Internet or WWW are electronic and digital transactions being monetary or otherwise. Examiner would like to suggest to the applicant to change all the cyber and cyber space phrase with electronic for clarity of the claims.

(Office Action Made Final mailed December 14, 2006, paragraph no. 6, page 3).

Applicant respectfully submits that this objection is improper. It is well-settled law that the applicant is entitled to be his own lexicographer.¹ Further, applicant's original disclosure provides substantial information as to what a cyber payment is. For example, the instant application as originally filed discloses,

Cyber payment means, which will be explained later, includes various electronic payment means, such as cyber promissory notes (hereinafter, referred to as cyber notes), cyber checks, and cyber payment certificates. Here, cyber payment certificates means electronic payment certificates based on receivables of trade and will be treated similarly to cyber notes in the present invention.

(Instant application as originally filed, page 8, lines 26-32).

Therefore, where, as here, the applicant has provided his own definition of a claim term, that definition will control interpretation of that term as it is used in the claim.² Furthermore, applicant's use of the term "cyber" is entirely consistent with the definition provided by Webster's Dictionary, which defines "cyber" as an adjective that means "of, relating to, or involving computers or computer networks (as the Internet)."³ Accordingly, applicant respectfully requests that this rejection be reconsidered and withdrawn.

C. Claim Amendments

In the outstanding Office Action Made Final, the Examiner rejected claim 7 and asserted, *inter alia*,

Furthermore, the step . . . "if a first user, who has the issued cyber payment means, . . . the cyber payment means being moved from the first user to the second user inside of the database" is conditional based on the "if a first user," makes a payment, therefore if there is no payment made by the first user there is no need of moving of data in a database.

(Office Action Made Final mailed December 14, 2006, paragraph no. 5, page 2).

¹ See, e.g., *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) and *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996).

² See, e.g., *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999)

³ "Cyber," *Merriam-Webster Online Dictionary*. 2007. <http://www.merriam-webster.com> (18 Jan. 2007).

By the instant amendment, claim 7 has been amended to more positively recite this aspect of claim 7. However, applicant respectfully submits that claim 7 is allowable over the cited prior art even without this amendment. Accordingly, applicant's arguments, presented below, refer to language of claim 7 prior to this amendment, in order to clearly relate these arguments to the Examiner's asserted rejection of claim 7.

D. Asserted Anticipation Rejection

In the outstanding Office Action Made Final, the Examiner maintained the rejection of claim 7 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,963,843 to Takatsu ("the Takatsu reference"). Applicant respectfully traverses this rejection for at least the reasons set forth below.

Applicant respectfully submits that the Takatsu reference fails to disclose, or even suggest, each and every element of claim 7. In the rejection of claim 7, the Examiner broadly asserted,

Takatsu clearly teaches [a] method . . . comprising the steps of:

. . .

(c) if a first user, who has the issued cyber payment means, performs payment to a second user, using the cyber payment means when the first user is connected to the server, the cyber payment means being moved from the first user to the second user inside of the database (See Takatsu figures 2-7 and associated text and column 2, line 30- column 9, line 28, column 12, lines 14-68, column 13, line 17- column 15, line 5, and column 15, lines 37-51).

(Office Action Made Final mailed December 14, 2006, paragraph no. 10, page 4).

However, applicant respectfully submits that this assertion is without merit. The Examiner failed to identify any elements of the Takatsu reference that purportedly correspond to the elements recited in claim 7. Rather, the Examiner merely repeated applicant's claim language and accompanied it with a cite to six drawing figures and approximately 558 lines of text in the Takatsu reference. Applicants respectfully submit that none of the cited portions of the Takatsu reference, nor any other portion of the reference, discloses or suggests "if a first user, who has the issued cyber payment means, performs payment to a second user, using the

cyber payment means when the first user is connected to the server, the cyber payment means being moved from the first user to the second user inside of the database,” as recited in claim 7.

In the amendment filed on October 4, 2006, applicant argued that the Examiner had failed to set forth a *prima facie* case of anticipation for at least the reason that the Takatsu reference fails to disclose, or even suggest, *inter alia*, the “cyber payment means being moved from the first user to the second user inside of the database.” In the outstanding Office Action Made Final, the Examiner asserted that applicant’s arguments were not persuasive, stating,

It should be noted that the way the applicant has described the step is that of a physical move of data, which is not possible in the electronic domain of databases. Data is moved from one area to another by deleting one and adding one. As you would cut and past in cell tables of a database.

(Office Action Made Final mailed December 14, 2006, paragraph no. 5, page 2).

However, applicant respectfully submits that the Examiner has failed to address the underlying issue, *viz.*, that the Takatsu reference fails to describe “the cyber payment means being moved from the first user to the second user inside of the database,” as recited in claim 7. Despite the Examiner’s semantic attack on applicant’s arguments as inaccurately describing the claimed move “from the first user to the second user inside of the database” as a physical move, the rejection still does not address the salient point. In particular, applicant respectfully submits that the system described in the Takatsu reference does not move a “cyber payment means . . . from the first user to the second user inside of the database,” as recited in claim 7, regardless of whether it is a physical move or not.

The Takatsu reference describes a system that transfers payment by relying on the transmission of an “authentication code 73” via a network such as the internet, and/or the physical transfer of an “exchange value unit identification code 71” via physical transfer on paper.⁴ In contrast, claim 7 recites a system that does not require such transfers. Rather, the cyber payment means recited in claim 7 is moved inside of the database.

⁴ The Takatsu reference describes the “authentication code 73” as the means by which an electronic note is conveyed throughout the system, stating, “the electronic note generation program 52 determines the amount of an electronic note to be generated and prepares the authentication code 73 which represents an electronic note

Clearly, since the authentication code 73 employed in the Takatsu reference may be exposed during transmission across the internet and/or decrypted (hacked) by unauthorized individuals, the Takatsu reference describes a system with significant intrinsic security problems. Thus, not only does the Takatsu reference fail to disclose “the cyber payment means being moved from the first user to the second user inside of the database,” as recited in claim 7, it wholly fails to recognize a significant advantage that this aspect of the claimed system provides, viz., the increased security that is achieved by moving the cyber payment means within the database instead of transmitting it.⁵ Accordingly, applicant respectfully submits that the Takatsu reference fails to suggest, much less disclose, each and every element of claim 7.

Further, applicant notes that claim 7 recites a system in which the cyber payment means is marked with a business identifier of the user. In particular, claim 7 recites,

a database managed by the server computer,
wherein the server computer is configured to:
receive member information including business identification
information . . .
issue the cyber payment means . . . , the cyber payment means
being marked with at least a business identifier of the
corresponding user . . .

In contrast to the system recited in claim 7, the system described in the Takatsu reference fails to teach such a business identifier. Accordingly, in addition to the teachings note above as missing from the Takatsu reference, applicant respectfully submits that the Takatsu reference fails to suggest, much less disclose, this aspect of claim 7.

of that amount.” *See the Takatsu reference at col. 11, lines 49-51.* Further, it is clear that transactions involving the authentication code 73 may involve multiple transmissions across a network such as the internet (*see FIG. 2 of the Takatsu reference*). Moreover, it is clear that physical movement, i.e., hand-carrying, is required for the transmission of the “exchange value unit identification code 71” that is used to authorize generation of the electronic note and the authentication code 73. (*See the Takatsu reference at, e.g., col. 12, lines 28-34, which states “The exchange value unit identification code 71 functions as an evidence of authorization . . . to generate an electronic note. . . . This identification code 71 . . . may be printed on paper. . . .”*).

⁵ The security risks intrinsic to the system described in the Takatsu reference clearly significant, since the Takatsu reference employs an “electronic note list 74” in an attempt to catch fraudulent electronic notes. *See, e.g., the Takatsu reference at col. 12, lines 63-66, which states, “The electronic note list 74, which includes information of an electronic note which is currently circulated, . . . is used to discriminate whether or not an electronic note is valid.”*

In view of the above, applicant respectfully submits that the Takatsu reference fails to anticipate claim 7. Accordingly, claim 7 is believed to be allowable over the Takatsu reference. Therefore, applicant respectfully requests that this rejection be reconsidered and withdrawn.

E. Asserted Obviousness Rejections

In the outstanding Office Action Made Final, the Examiner rejected claims 13, 15, 16 and 18 under 35 U.S.C. § 103(a) as being unpatentable over the Takatsu reference. Applicant respectfully traverses this rejection. Claims 13, 15, 16 and 18 each depend, either directly or ultimately, from claim 7, and are therefore believed to be allowable for at least the reasons that claim 7 is allowable. Therefore, applicant respectfully requests that this rejection be reconsidered and withdrawn.

F. Allowable Subject Matter

Applicant appreciates the Examiner's indication that claim 17 recites allowable subject matter. By the instant amendment, claim 17 has been rewritten in independent form. Accordingly, applicant respectfully submits that claim 17 is in condition for allowance, and a notice to that effect is respectfully requested.

G. Entry Requested

Applicant respectfully submits that the pending claims are in condition for allowance. The amendments to the claims overcome the outstanding objections and/or place the claims in better form for appeal. Accordingly, entry of the instant amendment is respectfully requested.

H. Conclusion

The remaining documents cited by the Examiner were not relied upon to reject the claims. Therefore, no comments concerning these documents are considered necessary at this time.

If the Examiner believes that additional discussions or information might advance the prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number listed below to expedite resolution of any outstanding issues.

In view of the foregoing amendments and remarks, reconsideration of this application is earnestly solicited, and an early and favorable further action upon all the claims is hereby requested.

Respectfully submitted,

LEE & MORSE, P.C.

Date: April 16, 2007


Eugene M. Lee, Reg. No. 32,039

Attachment:
Petition for Extension of Time (1 month)

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PETITION and
DEPOSIT ACCOUNT CHARGE AUTHORIZATION

This document and any concurrently filed papers are believed to be timely. Should any extension of the term be required, applicant hereby petitions the Director for such extension and requests that any applicable petition fee be charged to Deposit Account No. 50-1645.

If fee payment is enclosed, this amount is believed to be correct. However, the Director is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-1645.

Any additional fee(s) necessary to effect the proper and timely filing of the accompanying-papers may also be charged to Deposit Account No. 50-1645.